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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,884	07/31/2001	Chin-Shan Tsai	TSAI3039/EM/7066	2069
2292	7590	03/10/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			UBILES, MARIE C	
			ART UNIT	PAPER NUMBER
			2642	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/917,884

Applicant(s)

TSAL, CHIN-SHAN

Examiner

Marie C. Ubiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 recites the limitations "bidirectional signals" in line 6, "signals" in line 9 and "signal" in line 11. There is insufficient antecedent basis for this limitation in the claim.
3. Claims 1-7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For example, in claim 1, please refer to the limitation from lines 9-12. In claim 5, lines 5-6, the Applicant recites "portions which are symmetrically".

Further in claim 1, lines 12-14 the Applicant added a limitation that merely describes the so-called benefits of the invention.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1-4 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Carley (US 6,542,735).

As for claim 1, Carley discloses a wireless earphone with a mainframe separated with an output unit comprising a mainframe having a signal portion having a transmission chip (See Fig. 1; elements 13 and 15), a message processing unit (or transceiver 15) for bidirectionally receiving/transmitting far-end bidirectional signals (See Col. 5, lines 41-46); and a positioning unit assembled and clamped in a human body (as read on "transceiver 15 worn by the presenter")(See Col. 5, line 40-41); and an output unit having a voice emitting unit arranged at an ear of the human body and outputting signals (inherent of the function to be performed by the "ear phone" of cordless headset 13), a receiving unit arranged at the speaking portion of the human body (inherent of the function performed by the "microphone" of cordless headset 13) and then inputting signal to the message processing unit through a transmission line (it may be appreciated in Fig. 2 that the transceiver 15 and cordless headset 13 are connected by means of a wire or transmission line) ; wherein the mainframe is separated with the output unit (See Col. 5, lines 36-46).

As for claim 3 limitation regarding "...message processing unit is further installed with a microphone for informing incoming message to the user", reads on the functions

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performed by the microphone of the "cordless headset 13" disclosed by Carley; the claimed "installed microphone" reads into the microphone of Carley's system as connected to the "message processing unit" (or transceiver 15) by means of a wire –or transmission line.

As for claim 4, it is inherent that RF transceivers (or transceiver 15) possesses means to control reception and transmission of signals.

Claim 7 is rejected for the same reasons as claim 1.

As for claim 2, the Examiner takes Official Notice that systems and methods exists in the art to inform a user of an incoming message, the limitation reads, for example, in light sources (i.e. LEDs) used to notify the user of a cellphone of an incoming communication.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carley et al. (US 6,542,735).

Carley teaches a "message processing unit" (or transceiver 15) connected to a cordless headset by means of a wire. While the use of a "receptacle which is

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conformable to a plug at an end portion of the transmission line", it is well-known in the art that such means may be provided as some sort of temporary connection, thus in this manner the rapid replacement of a headphone/earphone is achieved by the user in case of improper function or damage.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carley (US 6,542,735) in view of Kao (US 2002/0072387).

While Carley does not disclose how will the "message processing unit" (or transceiver 15) be used by the presenter (See Col. 5, lines 4041); the use of clamps, clips and other means for attaching communication devices to one body are well-known in the art. Regarding the discussed matter, please see element 82, Fig. 1(b) of Kao.

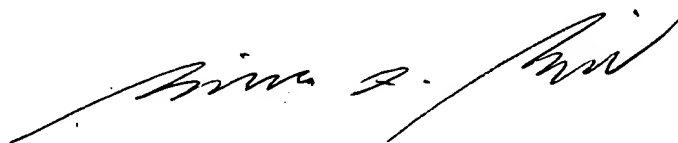
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles  
January 7, 2005.

A handwritten signature in black ink, appearing to read "Bing Q. Bui", is written over a horizontal line.

**BING Q. BUI**  
**PRIMARY EXAMINER**